UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

omelko

Mailed: March 14, 2005

Opposition No. 91159613

Murphy Law Firm

v.

Michles & Booth, P.A.

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Before Hohein, Hairston and Chapman, Administrative Trademark Judges.

By the Board:

Background

On November 5, 2002, Michles & Booth, P.A. (hereinafter "applicant") filed an application for the mark DON'T BE A VICTIM TWICE for services described as "advertising of law firm" based on an alleged bona fide intention to use the mark in commerce.[1] During the course of examination, the examining attorney issued an Office action in which he indicated the following:

> The wording "advertising of law firm" in the recitation of services is unacceptable as indefinite. It does not appear from the record that the applicant intends to be in the business of advertising law firms for others but rather intends to offer services of a law firm in relation to the proposed mark. For example, the wording "services of a law firm namely legal services" is acceptable and may be adopted, if accurate.

[1] Application Serial No. 78181658, filed November 5, 2002.

Applicant responded that it was not in the business of advertising law firms for others and amended its recitation of services to that proposed by the examining attorney. The mark was subsequently published for opposition.

Murphy Law Firm (hereinafter "opposer") opposed registration based on allegations of priority of use of the identical mark for "legal services" and a likelihood of confusion due to applicant's mark for its legal services; the improper broadening of applicant's recitation of services in the involved application; and applicant's lack of bona fide intent to use its mark in commerce in connection with the services identified in the application as originally filed.

Applicant, in its answer, denied the salient allegations of the notice of opposition and asserted the affirmative defenses of estoppel and lack of standing.[2]

This case now comes up for consideration of opposer's motion (filed on August 3, 2004) for summary judgment on the issue of whether applicant improperly broadened the recitation of services in the involved application or, in the alternative, whether applicant lacked a bona fide intent to use the mark in connection with the services as originally identified; and applicant's cross-motion (filed

[2] Although applicant also pleaded the affirmative defense of unclean hands, the Board, on June 14, 2004 granted opposer's motion to strike such defense.

September 14, 2004) for summary judgment in its favor on those two issues as well as for summary judgment on the issue of priority of use. The motions have been fully briefed by the parties.[3]

Summary judgment is an appropriate method of disposing of cases in which there is no genuine issue of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co*., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc*., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992), and *Olde Tyme Foods Inc. v. Roundy's Inc*., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *See*

[3] Applicant's consented motion (filed September 3, 2004) to extend its time to respond to opposer's motion for summary judgment is hereby approved; and opposer's consented motion (filed September 21, 2004) to extend its time to file a reply brief for its summary judgment motion is hereby approved.

Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993), and *Opryland USA, supra*.

The mere fact that both parties have filed motions for summary judgment does not necessarily mean that there is no genuine issue of material fact, and that trial is unnecessary. *See University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994); and 10A Wright, Miller & Kane, *Federal Practice & Procedure: Civil 3rd*, § 2720 (1998).

Standing

We turn first to the question of if there is a genuine issue of material fact as to whether opposer has standing to bring this opposition. In *Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Court of Appeals for the Federal Circuit enunciated a liberal threshold for determining standing, that is, whether one's belief that one will be (is) damaged by the registration is reasonable and reflects a real interest in the case.

In its motion, opposer has provided the declaration of Peyton P. Murphy, a principal in opposer’s law firm, who declares that opposer has continuously used DON’T BE A VICTIM TWICE as a service mark for legal services since before the November 5, 2002 filing date of the involved application. Specifically, Mr. Murphy avers that opposer’s television commercial using the phrase DON’T BE A VICTIM

TWICE aired at least as early as July 15, 2002 and, since then, it has aired two hundred to three hundred times per year; and that opposer has also used the phrase in advertising in the yellow pages and on its letterhead stationery since before November 5, 2002, and continuing to the present. In support of its motion, opposer includes a copy of the television broadcast invoice and a copy of opposer's brochure.

In response, applicant argues that opposer does not have standing because applicant first used DON'T BE A VICTIM TWICE in 2001 and opposer first used the same mark in 2002; that because applicant has prior use of the service mark, opposer cannot demonstrate that it will suffer damage if applicant registers the mark; and that, as such, opposer does not have standing to bring this opposition.

While not pleaded as a basis for its standing, opposer argues in reply that it has conclusively demonstrated its standing by submitting evidence of its use of the identical mark in connection with legal services prior to the filing date of the involved application. Opposer has submitted a copy of the Office action notifying it of the suspension of opposer's application[4] pending determination of the registrability of the involved application.

[4] Application Serial No. 78251783, filed May 19, 2003.

It is pointed out that applicant's arguments are directed to the issue of priority of use rather than standing, which requires only a showing of a real interest to bring this proceeding. Opposer's submission of the Office action referenced above sufficiently demonstrates that, contrary to applicant's contentions, there is no genuine issue of material fact as to opposer's standing in that it has a real interest in this proceeding. *See Cunningham v. Laser Golf Corp., 222 F.3d 942, 55 USPQ2d 1842 (Fed. Cir. 2000); and The Hartwell Co. v. Shane, 17 USPQ2d 1569 (TTAB 1990).*

Cross-Motions for Summary Judgment on the Issue of whether Applicant Improperly Broadened the Recitation of Services in the Involved Application

Opposer maintains that applicant's amendment of the recitation of services in its involved application effectively constitutes a wholesale replacement of applicant's original recitation (advertising services) with a completely different recitation (legal services). Opposer further argues that the standard in ex parte cases--that an applicant can amend the application to clarify or limit, but not to broaden, the recitation of services--should apply to inter partes cases as well. Opposer's rationale is that if a broadening amendment is permitted, prejudice may result against third parties who search the USPTO records during the period between the original filing date and the entry of

the amendment and act, or do not act, in reliance on the original recitation of services.

In response, applicant provides the declaration of Marcus J. Michles, II, a principal in applicant's law firm, who declares that the original recitation of services in the involved application was intended to reflect applicant's intent to use the service mark in its efforts at marketing the legal services applicant provides; that in response to the examining attorney's statement that the wording of the recitation of services was indefinite, applicant amended its recitation of services to that suggested by the examining attorney, who then accepted the amendment. Applicant relies on TMEP § 1402.07(b) (3d ed. Rev. 2), to support its position.

In reply, opposer argues that the word "advertising" identifies a well-recognized, separate service for which applicants may apply to register marks.

In this case, we agree with applicant that its amendment is permissible to clarify an ambiguity. As stated in TMEP § 1402.07(b) (3d ed. Rev. 2), in pertinent part:

> An applicant may amend an ambiguous identification of goods or services (i.e., an identification that fails to indicate a type of goods or services) in order to specify definite goods or services within the scope of the indefinite terminology.... Likewise, if the applicant includes wording in an indefinite identification of goods or services that, in context, is obviously surplus, the applicant may amend the identification to specify goods or services within the scope of the

> indefinite terminology. In many cases, the surplus wording will not restrict the range of permissible amendments.
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> > Example - If the applicant begins an indefinite identification of goods with surplus wording such as "sale of . . .," "publishing of . . .," "advertising of . . .," "manufacture of . . .," or similar wording, the applicant may amend to specify either goods or services within the scope of the existing identification. However, the specific terms used to preface the goods do establish some limitation as to scope. "Sale of" may justify an amendment to retail or mail order services for specific goods, but not to custom manufacturing or advertising agency services related to those goods.

Opposer's arguments would have some merit if applicant had initially identified its services in the application as "advertising **services** of law firm." We find, however, that as a matter of law, applicant properly clarified its ambiguous recitation of services rather than impermissibly broadening such. The amended recitation, that is "services of a law firm namely legal services," is the operative recitation of services.

Accordingly, opposer's motion for summary judgment on this issue is denied and applicant's cross-motion for summary judgment on this issue is granted.

Cross-Motions for Summary Judgment on the Alternative Issue of whether Applicant Lacked a Bona Fide Intent To Use the Mark in Connection with the Services as Originally Identified

In the alternative, opposer argues that applicant admitted, in response to opposer's request for admission, that it did not have a bona fide intent to use the mark in connection with "advertising of law firm" and, in response to the examining attorney's Office action, stated that "[i]t is true that we are not in the business of advertising law firms for others. We only intend to offer the services of a law firm in relation to the proposed mark." Opposer has included a copy of applicant's signed response to opposer's request for admission, and a copy of applicant's response to the examining attorney. As such, opposer argues that applicant did not have the requisite bona fide intent to use the mark on the services recited in the application as originally filed.

Inasmuch as we have determined that applicant properly amended its initially ambiguous recitation of services from "advertising of law firm" to "services of a law firm namely legal services," opposer's motion for summary judgment on the alternate ground that applicant lacked the requisite bona fide intent to use the mark in connection with "advertising of law firm" is not well taken.

Accordingly, opposer's motion for summary judgment on this issue is denied; and applicant's cross-motion for summary judgment on this issue is granted.

Applicant's Motion for Summary Judgment on the Issue of Priority of Use

Pursuant to Section 2(d) of the Trademark Act, a plaintiff must assert, and then prove, at trial or on summary judgment, that defendant's mark, as applied to its goods or services, so resembles plaintiff's previously used or registered mark or its previously used trade name as to be likely to cause confusion, mistake or deception. It is noted that the only real issue raised in applicant's motion for summary judgment, and in opposer's response, is the question of priority of use. Neither party has attempted to establish that a genuine issue of material fact exists in regard to the question of likelihood of confusion, since in essence the parties claim rights in the identical mark for identical services.

Applicant has included with its motion the declaration of Marcus J. Michles, II, a principal in applicant's law firm, who declares that in late 2001, he created the phrase DON'T BE A VICTIM TWICE to be used as a service mark in connection with the firm's advertising efforts for its legal services; that in December 2001, the firm arranged for the production of a television advertisement using the mark DON'T BE A VICTIM TWICE for its legal services which aired

for the first time on December 31, 2001, and ran for a month; that since that time applicant has continued using the mark in connection with its services and has expanded its use to print and radio advertising.

In support of its motion, applicant includes copies of its business records relating to the television, radio and print advertisements, specifically (i) an invoice from Vision Design Productions, dated December 18, 2001, referencing two thirty second television commercials; (ii) undated transcripts of radio advertisements; (iii) print advertisements, including one dated April 11, 2003; and (iv) invoices showing advertising in these media during the time frame of February 12, 2002 to March 14, 2004.

In response, opposer argues that applicant has not indisputably established a date of use as a service mark prior to opposer's July 15, 2002 date of use and, therefore, cannot claim priority over opposer. In particular, opposer maintains that applicant has not made of record specimens of its claimed use via radio and television commercials and, therefore, has not established that such usage constitutes service mark usage (as opposed to descriptive, informational, or generic usage). In addition, opposer argues that the print advertisements for which applicant has provided copies show dates of such use that are subsequent to opposer's use of July 15, 2002. Further, opposer submits

that opposer's explicit statement that its use was "at least as early as July 15, 2002" plainly allows for the possibility at some future time in this proceeding to submit evidence of use earlier than July 15, 2002. Opposer concludes that the insufficiency of the evidence submitted by applicant to establish applicant's use of the term DON'T BE A VICTIM TWICE results in a genuine issue of material fact with respect to priority of use.

In reply, applicant argues that opposer has failed to put forward evidence necessary to support its claim of priority of use. Specifically, applicant maintains that applicant has come forward with evidence that it first used DON'T BE A VICTIM TWICE in commerce on or about December 31, 2001, and that it has continued to use the mark in the months and years that followed. Applicant further argues that despite having the opportunity to do so, opposer has failed to come forward with any evidence of its own use prior to December 31, 2001; and that the only evidence opposer has produced indicates that opposer's first use is six months after applicant's first use. Further, applicant argues, opposer's statement that later in the proceeding it may prove use earlier than applicant's December 31, 2001 date fails to satisfy opposer's obligation to defend against applicant's motion for summary judgment on the issue of priority of use.

In response to opposer's contention that it is impossible to conclude that applicant used the mark DON'T BE A VICTIM TWICE to identify and distinguish the source of applicant's services, applicant argues that the transcripts of its radio advertisements show that the mark is used therein in a prominent position, preceded by information regarding the legal services offered by applicant and immediately followed by the applicant's name and contact information.

Included with applicant's reply is the declaration of Margaret Edwards, an employee of applicant, who declares that in December 2001, applicant arranged for the production and broadcast of two television advertisements using the mark DON'T BE A VICTIM TWICE, copies of which appear on the videotape submitted with the reply brief.

The Board has viewed the specimens for which applicant claims its earliest use date, namely the videocassette for the two commercials applicant's principal declares were aired on December 31, 2001. Before the actual commercial, a page appears on the screen that shows the December 31, 2001 date. The commercials clearly show service mark use of the mark DON'T BE A VICTIM TWICE in relation to legal services. The commercials identify applicant's law firm and a telephone number so that potential clients may contact the firm for legal services. The phrase is emphasized by the

appearance of the words DON'T BE A VICTIM TWICE on the screen at the same time the speaker speaks them, and by the speaker pausing before and after speaking the phrase.

Applicant's evidence shows that it has used the mark DON'T BE A VICTIM TWICE since December 31, 2001 and continuing to the present.

We disagree with opposer's argument that the phrase DON'T BE A VICTIM TWICE may be used in a descriptive, informational or generic manner. Opposer submitted no evidence to support this argument. Furthermore, the argument is somewhat disingenuous since opposer is using the identical phrase for the identical services. We find that when viewed in connection with the services recited in the application, there is no uncertainty as to the service mark significance of the phrase.

We find no merit in opposer's argument that opposer may offer proof of use earlier than applicant has established at some time later in this proceeding. Applicant offered evidence of its claim of priority of use of the mark and it was opposer's responsibility to come forward with its own evidence, if available, of use earlier than that which applicant established by its motion for summary judgment. In countering a motion for summary judgment, more is required than mere assertions of counsel. The non-movant may not rest on its conclusory pleadings but, under Fed. R.

Civ. P. 56, must set out, usually in an affidavit by one with knowledge of specific facts, what specific evidence could be offered at trial. *Sweats Fashions v. Pannill Knitting Co.,* 4 USPQ2d 1794 (Fed. Cir. 1987).

Applicant's evidence has established that there is no genuine issue as to priority of use; that it is applicant which has priority of use rather than opposer; and that applicant is entitled to judgment as a matter of law on this issue.

Accordingly, applicant's motion for summary judgment on the issue of priority of use is granted.

Having decided all the issues raised in the notice of opposition in favor of applicant, the opposition is dismissed.